

### **REMARKS**

Claims 1-23 are presently pending. Claims 1, 6, 13, and 23 have been amended. Therefore, claims 1-23 remain pending in the present application.

As a preliminary matter, the Applicants note that there is a typographical error associated with the filing receipt. The filing receipt incorrectly lists the surname of inventor Benjamin T. Gomez as "Benjamin T. Gornez". The Applicants will be taking the proper steps to correct this error.

### **Claim Rejections – 35 U.S.C. § 101**

Claim 20 has been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Applicants note that claim 20 depends from independent claim 19. Claim 19 includes signaling a drive mechanism to extend a selected extendable display into a field of view of a player, thereby resulting in a physical transformation outside the computer. Because claim 19, from which claim 20 depends, is directed to statutory subject matter, the Applicants respectfully submit that claim 20 is also directed to statutory subject matter.

For at least these reasons, the Applicants respectfully request that the rejection of claim 20 under 35 U.S.C. § 101 be withdrawn.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 1-10, 13-19, and 21-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,159,095 to Frohm et al. ("Frohm"). The Applicants respectfully request that the Examiner reconsider and withdraw this rejection in light of the following remarks.

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim". *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

### **Independent Claim 1**

Independent claim 1 of the present invention requires an “extendable display having a first position out of a field of view of a player and a second position in a field of view of a player”. Additionally, claim 1 requires “a drive mechanism connected to the extendable display adapted to move the extendable display in a first direction from the first position to the second position and adapted to move the extendable display in a second direction from the second position to the first position”. Claim 1 further requires “a central processing unit adapted to signal the drive mechanism to translate the extendable display between the first position and the second position.”

Frohm is directed to an electronic video gaming machine for simultaneously playing multiple games. Frohm, Abstract, col. 1, ll. 11-12, col. 2, ll. 22-23. Multiple game boards are arranged in a stacked fashion. *Id.*, Abstract, col. 2, ll. 33-34. A player may select from the stack a number of game boards to be played. *Id.*, Abstract, col. 2, ll. 41-42. Thus, the gaming machine of Frohm allows a player to play multiple hands at once, thereby increasing the chance of at least one hand resulting in a winning combination. *Id.*, col. 1, ll. 40-42.

The Applicants respectfully submit that Frohm does not disclose, teach, or suggest every element of claim 1. For example, Frohm does not disclose, teach, or suggest an “extendable display having a first position out of a field of view of a player”, as required by claim 1. In support of the contrary assertion, the Office Action relies on a portion of Frohm stating, “The face of any game board is viewable by the player by touching the touch screen at a location of the game board to be viewed.” Frohm, col. 2, ll. 46-49; *see also, id.*, col. 6, ll. 20-22. The relied upon portion further states, “After touching the game board, the game board slides out from the stack to expose its face.” *Id.*, col. 2, ll. 49-50. In order for the player to be able to touch and select the game board, at least a portion of the game board must be within the player’s field of view prior to the game board sliding out. Thus, the game board in Frohm is always at least partially in a field of view of a player. The Applicants’ position is supported by Figures 1, 2, and 4-6 of Frohm, which illustrate a portion of each of the game boards being within a player’s field of view on a video screen. Thus, the Applicants respectfully assert that nowhere in this cited portion, or in any other portion, of Frohm is an extendable display having a first position out of a field of view of a player disclosed.

Additionally, Frohm does not disclose the element of “a drive mechanism connected to the extendable display adapted to move the extendable display in a first direction from the first

position to the second position and adapted to move the extendable display in a second direction from the second position to the first position.” FIG. 7 of the present invention provides an example of how the drive mechanism 65 may be connected to the extendable display 41. In making its rejection, the Office Action relies upon a portion of Frohm stating that “the winning game board appears to pop-up from the stack in cash-register-like fashion such that the face of the winning game board is more visible relative to prior said game board popping up.” *Id.*, col. 2, ll. 42-45. Nowhere in this cited portion, or any other portion of Frohm, is a drive mechanism disclosed. The reason for this is that Frohm’s game boards are on a video display where no drive mechanism is present. Furthermore, Frohm does not disclose “moving the extendable display in a second direction from the second position to the first position”, as required by claim 1. Frohm makes no mention whatsoever about what happens to the game board after it is made more visible to the player (e.g., “pops-up”). Presumably, once the game board is made more visible to the player, the game ends, and, thus, the game board never returns to its original, partially obstructed position. Thus, the Applicants respectfully submit that this element of claim 1 is also not disclosed by Frohm.

Accordingly, because the Applicants submit that a drive mechanism is not disclosed in Frohm, the element of “a central processing unit adapted to signal the drive mechanism to translate the extendable display” is also not disclosed.

Thus, the Applicants respectfully submit that claim 1 is allowable over Frohm because Frohm does not disclose every element of the claim. The Applicants respectfully submit that claims 2-8, which depend from claim 1, are allowable for at least the same reasons.

## **Dependent Claim 2**

Claim 2, which depends from claim 1, further requires “an aperture adapted to allow the player to view the extendable display in the second position” (emphasis added). The Office Action has rejected claim 2 as being anticipated by Frohm because “Frohm discloses a gaming machine wherein the game display has an aperture adapted to allow the player to view the extendable display in the second position”. Office Action, p. 3-4. In support of this assertion, the Office Action cites the following portion of Frohm: “The face of any game board is viewable by the player by touching the touch screen at a location of the game board to be viewed. After touching the game board, the game board slides out from the stack to expose the face.” Frohm, col. 2, ll. 47-50. The Applicants

respectfully submit that this cited portion does not disclose a “simulated aperture,” as the Office Action suggests. Office Action, p. 4. Rather, the cited portion merely describes a traditional video gaming display where elements appear on the display. Thus, an aperture is neither required nor disclosed by Frohm and is, thus, not anticipated by Frohm.

Thus, for at least these reasons as well as for those reasons set forth above with respect to claim 1, the Applicants submit that claim 2 is allowable over Frohm.

#### **Dependent Claim 4**

Dependent claim 4, which depends from claim 1, further requires that “the drive mechanism rotates the extendable display between the first position and the second position” (emphasis added). The portion of Frohm relied upon by the Office Action in making this rejection states, “After touching the game board, the game board slides out from the stack to expose its face.” Frohm, col. 2, ll. 49-50 (emphasis added). The Applicants respectfully submit that sliding is completely different than rotating, as required by claim 4. Furthermore, the gaming machines of Frohm merely include graphical images depicting the game boards sliding but do not actually physically slide. This is clearly distinguishable from claim 4, which requires that the drive mechanism actually physically rotate the extendable display. Frohm also states that “the winning game board appears to pop-up from the stack in a cash-register-like fashion.” Frohm, Abstract, col. 2, ll. 43-45, col. 5, *see also*, col. 5, ll. 43-45. Again, popping-up in a cash-register-like fashion is far different than rotating. Therefore, the limitations of claim 4 are not disclosed, taught, or suggested by Frohm.

Thus, for at least these reasons, as well as for the reasons set forth above with respect to claim 1, the Applicants submit that claim 4 is allowable over Frohm.

#### **Dependent Claim 7**

Claim 7, which depends from independent claim 1, requires that “the extendable display is a scroll mechanism having a plurality of indicia, each of the plurality of indicia being individually selectable.” In finding claim 7 to be anticipated by Frohm, the Office Action relies on a portion of Frohm that states, “In one embodiment, the player selects the number of game boards 20 in each stack section 88 by using indicators 32 or buttons 46 on the deck 70 to increase the number of game boards 20.” Office Action, p. 4; Frohm, col. 5, ll. 8-11. This cited portion does not disclose a “scrolling mechanism,” as required by claim 7. The Office Action summarizes this relied upon

portion as disclosing “a plurality of game boards in a stack [that] may be selected and extended.” Office Action, p. 4. Assuming, *arguendo*, that this summary is accurate, it still does not explain how the disclosure of a “scrolling mechanism” may be gleaned from the relied upon portion – or any other portion – of Frohm. The Applicants submit that the reason for this is that the scrolling mechanism element of claim 7 is **not** disclosed in Frohm.

Thus, the Applicants submit that claim 7 is allowable for at least these reasons as well as for the reasons discussed above with respect to independent claim 1.

### **Independent Claim 8**

The Applicants respectfully submit that independent claim 8 and its dependent claims 9-12 are allowable for at least the reasons set forth above with respect to claim 1.

### **Dependent Claim 9**

The Applicants respectfully submit that claim 9, which depends from claim 8, is allowable for at least the reasons set forth above with respect to claims 4 and 8.

### **Independent Claim 13**

Claim 13 requires “locating an extendable display in the game display in a first position out of a field of view of a player” and “moving the extendable display in a first direction to a second position.” Claim 13 further requires “moving the extendable display in a second direction to return the extendable display to the first position.” Frohm does not disclose the act of **locating** an extendable display. Additionally, as discussed above with respect to claim 1, Frohm does not disclose “a first position **out of a field of view of a player.**” Furthermore, as detailed above regarding claim 1, Frohm does not disclose returning the game boards to their original positions. Thus, the “first direction” and “second direction” limitations of claim 13 are not disclosed in Frohm.

Therefore, for at least these reasons, as well as for the reasons provided above with respect to claim 1, the Applicants respectfully submit that claim 13 and its dependent claims 14-18 are allowable over Frohm.

### **Dependent Claim 15**

The Applicants respectfully submit that claim 15, which depends from claim 13, is allowable for at least the reasons set forth above with respect to claims 2 and 13.

### **Dependent Claim 17**

The Applicants respectfully submit that claim 17, which depends from claim 13, is allowable for at least the reasons set forth above with respect to claims 4 and 13.

#### **Independent Claim 19**

The Applicants respectfully submit that claim 19 and its dependent claims 20-22 are allowable for at least the same reasons set forth above with respect to claims 3, 8, and 13.

#### **Dependent Claim 21**

The Applicants respectfully submit that claim 21, which depends from claim 19, is allowable for at least the reasons set forth above with respect to claims 4 and 19.

#### **Independent Claim 23**

Claim 23 requires an extendable display “having a first position out of a field of view of a player, the extendable display further having a second position partially in a field of view of a player, the extendable display further having a third position in a field of view of a player”. As described above with respect to claim 1, Frohm does not disclose “a first position out of a field of view of a player.” The requirement of claim 23 that the extendable display have three distinct positions further makes it clear that the element of “a first position out of a field of view of a player” is not disclosed in Frohm. Accordingly, the limitation “a central processing unit adapted to signal the drive mechanism to translate the extendable display from the first position to the second position” is also not anticipated by Frohm.

Thus, for at least these reasons as well as for the other reasons discussed above with respect to claim 1, the Applicants submit that claim 23 is allowable over Frohm.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Frohm.

First, the Applicants note that each of claims 11 and 12 depend from independent claim 8, the novelty of which is presented above. Thus, claims 11 and 12 are believed to be allowable for at least the same reasons as claim 8.

Furthermore, the portion of Frohm relied upon by the Office Action in rejecting claims 11 and 12 states, “The microprocessor then operates according to its game program . . . and, using technology well known in the art, causes each of the reels to stop at the preselected stop position.”

Office Action, p. 5; Frohm, col. 9, ll. 26-30. This disclosure essentially describes the operation of traditional mechanical gaming machines. Nowhere in Frohm is there disclosed "a plurality of concentrically oriented shafts," let alone connecting "each of the plurality of shafts . . . **to at least one extendable display**," as required by claim 11. Furthermore, nowhere in Frohm is there disclosed "a plurality of solenoid valves, each solenoid valve being connected to one of the plurality of extendable displays, each of the plurality of solenoid valves adapted to linearly translate the extendable display", as required by claim 12. The Applicants further submit that these elements would not have been obvious to one skilled in the art.

Thus, for at least these reasons, the Applicants submit that claims 11 and 12 are allowable over Frohm.

### **Conclusion**

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. The Applicants respectfully request that a timely Notice of Allowance be issued in this case. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is the Applicants' belief that no further fees are due at this time. However, should the Applicants be mistaken, the Commissioner is authorized to charge any fees that may be required (except for payment of the issue fee) to Jenkins & Gilchrist, P.C., Deposit Account No. 10-0447, Order No. 47079-00228USPT. A duplicate copy of this paper is enclosed.

Dated: December 6, 2006

Respectfully submitted,

By 

Daniel J. Burnham

Registration No.: 39,618

JENKENS & GILCHRIST, A PROFESSIONAL  
CORPORATION

225 W. Washington, Ste. 2600

Chicago, Illinois 60606-3418

(312) 425-3900

Attorney For Applicants